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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,895	08/06/2001	Bruce L. Daugherty	19634YDA	9048

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EXAMINER	
MERTZ, PREMA MARIA	
ART UNIT	PAPER NUMBER
1646	11

DATE MAILED: 07/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/922,895	Applicant(s) Daugherty et al.
	Examiner Prema Mertz	Art Unit 1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *May 23, 2003* .

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *36-49* is/are pending in the application.

4a) Of the above, claim(s) *43-49* is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *36-42* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). *10*
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

1. Claims 1-35 have been canceled previously. Claims 43-49 are drawn to non-elected claims. Claims 36-42 are under consideration.

The indicated allowability of claims 39-40 is withdrawn in view of the new 35 USC 102(e) rejections.

2. Receipt of applicant's arguments and amendments filed in Paper No. 9 (5/23/03) is acknowledged.

3. The following previous rejections and objections are withdrawn in light of applicants amendments filed in Paper No. 9, 5/23/03:

(i) the objection to the title of the invention

(ii) the objection to the disclosure of the invention

(iii) the rejection of claims 36-38, 41 under 35 U.S.C. § 101, and

(iv) the rejection of claim 42 under 35 U.S.C. § 112, first paragraph for the deposit requirements.

4. Applicant's arguments filed in Paper No. 9 (5/23/03), have been fully considered and were persuasive. The new issues are stated below.

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112, second paragraph

6. Claim 42 rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 42 recites the limitation "the AML14.3D10 cell line" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

Claim rejections-35 USC § 102(e)

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7a. Claims 36, 38-41, are rejected under 35 U.S.C. 102(e) as being anticipated by Gray et al. (US Patent No. 6,265,184).

Gray et al teaches a nucleic acid encoding chemokine receptor 88-2B, the nucleic acid having the nucleotide sequence set forth in SEQ ID NO:2 of the instant application (see abstract and SEQ ID NO:3-4 of the patent). The reference also teaches the terminator region of the nucleic acid

encoding chemokine receptor 88-2B (see SEQ ID NO:3). A copy of the comparison of SEQ ID NO:2 of the instant invention and the nucleic acid disclosed in the reference is enclosed at the end of this action (SEQUENCE COMPARISON A). The reference also discloses that the cDNA encoding the receptor was cloned into an expression vector, pRc/CMV, which contains a promoter operably linked to the cDNA insert encoding the receptor (column 11, lines 55-67; column 12, lines 1-19). Host cells were transformed with the cDNA in the vector (column 12, lines 20-67). Therefore, the cDNA sequence disclosed in the reference meets all the limitations of a nucleic acid as set forth in instant claims 36, 38-41.

7b. Gerard et al teaches a nucleic acid encoding chemokine receptor CCR3, the nucleic acid having the nucleotide sequence set forth in SEQ ID NO:2 of the instant application (see abstract and SEQ ID NO:3 of the patent). The reference also teaches the terminator region of the nucleic acid encoding chemokine receptor CCR3 (see SEQ ID NO:3). A copy of the comparison of SEQ ID NO:2 of the instant invention and the nucleic acid disclosed in the reference is enclosed at the end of this action (SEQUENCE COMPARISON B). The reference also discloses that the cDNA encoding the receptor was cloned into an expression vector, pcDNA, which contains a promoter operably linked to the cDNA insert encoding the receptor (column 48, lines 53-62). Host cells were transformed with the cDNA in the vector (column 48, lines 65-67; column 49, lines 1-41). Therefore, the cDNA sequence disclosed in the reference meets all the limitations of a nucleic acid as set forth in instant claims 36, 38-41.

Claim rejections-35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8a. Claims 36-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gray et al. (US Patent No. 6,265,184).

The disclosure of Gray et al has been set forth above in paragraph 7a. However, Gray et al do not teach the nucleic acid comprising SEQ ID NO:3 as in the instant application.

It would have been *prima facie* obvious to one of ordinary skill in the art at the time the instant invention was made to use the nucleic acid (cDNA encoding the 88-2B receptor) disclosed in the reference to obtain the 5' flanking region of the gene (SEQ ID NO:3) as disclosed in the instant application. To have obtained the 5' flanking region of the 88-2B receptor to be used in analysis and study of the regulation of the transcriptional elements and regulation of transcription of the 88-2B gene by employing those methods that were old and well known in the art of molecular biology at the time that the instant invention was made would have been *prima facie* obvious to an artisan in light of the Gray et al patent.

8b. Claims 36-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerard et al. (US Patent No. 6,537,764).

The disclosure of Gerard et al has been set forth above in paragraph 7b. However, Gerard et al do not teach the nucleic acid comprising SEQ ID NO:3 as in the instant application.

It would have been *prima facie* obvious to one of ordinary skill in the art at the time the instant invention was made to use the nucleic acid (cDNA encoding the CCR3 receptor) disclosed in the reference to obtain the 5' flanking region of the gene (SEQ ID NO:3) as disclosed in the instant application. To have obtained the 5' flanking region of the CCR3 receptor to be used in analysis and study of the regulation of the transcriptional elements and regulation of transcription of the CCR3 gene by employing those methods that were old and well known in the art of molecular biology at the time that the instant invention was made would have been *prima facie* obvious to an artisan in light of the Gerard et al patent.

Conclusion

No claim is allowed.

Advisory Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prema Mertz whose telephone number is (703) 308-4229. The examiner can normally be reached on Monday-Friday from 7:00AM to 3:30PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564.

Official papers filed by fax should be directed to (703) 305-3014 or (703 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 746-5300.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [yvonne.eyler@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express

waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Prema Mertz

Prema Mertz Ph.D.
Primary Examiner
Art Unit 1646
June 26, 2003